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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,614	12/30/2003	Brian Alan Grove	2043.033US2	9853

49845 7590 12/31/2009

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EXAMINER	
FADOK, MARK A	

ART UNIT	PAPER NUMBER
3625	

NOTIFICATION DATE	DELIVERY MODE
12/31/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/749,614	GROVE ET AL.	
	Examiner	Art Unit	
	MARK FADOK	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 August 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20,26-31,34-53 and 59-78* is/are pending in the application.

4a) Of the above claim(s) *3-7,9-20,28,30,31,36-40,42-53,61-65 and 67-78* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,8,26,27,29,34,35,41,59,60 and 66* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The examiner is in receipt of applicant's response to office action mailed 5/28/2009, which was received 8/24/2009. Acknowledgement is made to the amendment to claims 1,8,26,29,34,35,41,59,66, , the withdrawal of claims 3-20,28-31,36-53,61-78 and the cancellation of claims 21-25,32-33,54-58,79-83. The examiner has carefully considered applicant's amendment and remarks and finds them persuasive. However, after further search and consideration the following new ground of rejection necessitated by amendment follows:

Double Patenting

Claims **1,2,8,26,27,29,34,35,41,59,60 and 66** of this application conflict with claims 15,19,20,21,51,55,56,57,87,91,92,116 of Application No. 10/750,052. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims **1,2,8,26,27,29,34,35,41,59,60 and 66** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 15,19,20,21,51,55,56,57,87,91,92,116 of U.S. Patent No. 10/750,052. Although the conflicting claims are not identical, they are not patentably distinct from each other because similar recitations such as a reserve price of a proxy bid price being disseminated after a high proxy bid is identified.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1,2,8,26,27,29,34,35,41,59,60 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishi (US PG-Pub 20020161691) in view of Holden et al. (US Publication 20010032175A1), hereinafter Holden and further in view of Herschkorn (US Patent 6,691,094 B1).

Regarding claim 1, Nishi discloses a network-based commerce system including a processor coupled to a memory through a bus (see Fig1, paragraphs 0001-0029 and 0068-0071. The computer 4 performing the center processing includes a processor coupled to a memory through a bus for storing computer programs) and an auction price-setting process executed from the memory by the processor to cause the processor to adjust a reserve price associated with a listing of an item during a network-based auction price-setting process (see at least paragraphs 0088 and 0156-0174.). .

Regarding limitation, "notifying automatically one or more bidders of the adjustment of the reserve price", it would be implied that Nishi, via its computerized system communicates the adjustment of the reserved price to the bidders enabling them to consider it before making bids. Nishi does not explicitly teach that notification to bidders is carried out automatically via e-mail. However, it was well-known at the time of the applicant's invention to set automatic triggers for sending automatic notifications via emails to users/consumers, see Holden (at least paragraph 0082 and claim 28). In view of Holden, it would be obvious to one of an ordinary skilled in the art to set automatic triggers for automatically notifying one or more bidders about change in the reserve price because this enables efficient and real time communication of change in the ongoing auction terms which all bidders must know.

Nishi/Holden does disclose that the network-based commerce system of claim 1, wherein the auction price-setting process further causes the processor to automatically

notify a seller of the item when a high proxy bid is within a predetermined percentage range of the adjusted reserve price or within a predetermined value range of the reserve price. Herschkorn, in the same field of endeavor of matching sellers and buyers fairly suggest and discloses this limitation (see at least col.5, line 66-col.6, line 4, col.15, lines 56-67, col.24, lines 50-63, that is claims 9-10. Herschkorn teaches that the system/processor determines if the buyer's bid [corresponds to high proxy bid as recited in the claim] does not match with the seller's offer [corresponds to the seller's reserve price as recited in the claim] but is within a predetermined threshold, such as within 1-5 points or $100,000 both the seller and buyer are notified. In view of Herschkorn, it would be obvious to one of an ordinary skilled in the art that while conducting auctions for large valued items to modify Nishi to incorporate Herschkorn features because when the system determines that the buyer's bids does not match or exceed the seller's reserve price but they are within a predetermined proximity of the seller's reserve price either in points/percentage or value and informs about it to both the seller and buyer then there is a possibility that buyer and seller could negotiate and close the deal.

In further support of the rejection supra, the following is restated from the Decision on appeal affirming the examiner on claims of the same scope as the instant invention (see decision mailed in case 10750,052 mailed 9/25/2009).

"ANALYSIS

Teaching Away

We are not persuaded of error on the part of the Examiner by Appellants' argument that a combination of Nishi and Holden does not render obvious notifying one or more bidders of the adjustment of the reserve price, as recited in independent claims 15, 51, 87, and 116, because Holden teaches away from notifying bidders of the reserve price (App. Br. 10-16; Reply Br. 5-12). Holden discloses that the reserve price is not shown on the bidding screen. However, the fact that the reserve price is not shown does not mean Holden teaches away from showing the reserve price. A teaching away requires discouragement. See In re Gurley, 27 F.3d at 553. The cited portions of Holden do not discourage showing the reserve price. Indeed, independent claims 15, 51, 87, and 116 only recite notifying one or more bidders of the adjustment of the reserve price, and not notifying the one or more bidders of the reserve price itself. See CollegeNet, Inc. v. ApplyYourself Inc., 418 F.3d at 1231.

Adequate Reason for Modifying

We are not persuaded of error on the part of the Examiner by Appellants' argument that a combination of Nishi and Holden does not render obvious notifying one or more bidders of the adjustment of the reserve price, as recited in independent claims 15, 51, 87, and 116, because the Examiner has not provided an adequate reason for modifying Nishi (App. Br. 10-16; Reply Br. 5-12). Nishi discloses that assessor's equipment 16 includes a "reserve price modification button." Data submitted at the assessor's equipment 16 is sent to the buyer's equipment 20. While it is true that Nishi does not specifically disclose that reserve price modification is sent to the buyer's

equipment 20, Holden discloses that a variety of auction events will trigger automatic e-mail messages to the users authorized for that auction. The reserve price adjustment/modification may be such an event, as one of ordinary skilled in the art would set automatic triggers to automatically notify one or more bidders about change in the reserve price because this enables efficient and real time communication of change in the ongoing auction terms, even including a termination of an auction due to an adjustment of the reserve price and which all bidders should know (Ex. Arts. 6-8). Accordingly, all arguments that Nishi alone does not disclose the aforementioned aspects of independent claims 15, 51, 87, and 116 are unpersuasive, because it is the combination of Nishi and Holden in view of the above rationale that renders obvious the aforementioned aspects. See In re Keller, 642 F.2d at 426.

The Appellants assert that Nishi does not disclose disclosing the reserve price to the buyer's equipment 20. Once again, however, such a recitation is not set forth in the claims. See CollegeNet, Inc. v. ApplyYourself Inc., 418 F.3d at 1231. Independent claims 15, 51, 87, and 116 merely recite notifying one or more bidders of the adjustment of the reserve price, and not notifying the one or more bidders of the reserve price itself. The rationale for modifying Nishi to notify the one or more bidders about the change in reserve price has been established by the Examiner as set forth above.

The Appellants also assert that the Examiner's proffered combination of Nishi and Holden does not render obvious continuing the auction after the reserve price has been modified/adjusted, thus defeating the Examiner's rationale for combining Nishi and Holden. However, such a recitation is not set forth in the claims.

See CollegeNet, Inc. v. ApplyYourself Inc., 418 F.3d at 1231. Independent claims 15, 51, 87, and 116 merely recite notifying one or more bidders of the adjustment of the reserve price, not that the auction must subsequently continue. Accordingly, a termination of the auction still meets the aforementioned recitations, as long as the one or more bidders are informed of the modification/adjustment of the reserve price that terminates the auction."

Regarding claim 2, Nishi further suggests wherein the auction price-setting process further causes the processor to lower a proxy bid (withdraw automatically), of a buyer higher than the adjusted reserve price, to a predetermined amount below the adjusted reserve price (see at least paragraphs 0138-0145 and 0156-0174). If during an auction cycle the highest bid is less than the reserve price within a predefined range the auction process adjusts the reserve price and while doing so the maximum proxy bid/representation bid is also modified to, that is lowered to the highest bid plus a minimum bidding price unit.)

As an alternative to the above rejection to claims 2:

Claims 2, 27,35,60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishi (US PG-Pub 20020161691) in view of Holden et al. (US Publication 20010032175A1), hereinafter Holden and further in view of Herschkorn (US Patent 6,691,094 B1) and further in view of Churchill (7,461,022).

In regards to claim 2, Churchill teaches a wherein the auction price-setting process further causes the processor to automatically retract publication of the proxy bid information upon the high proxy bid exceeding the reserve price (FIG 9 and 10, high proxy bids and regular bids that did not originally surpass reserve price are published and revaluated for receiving a sold indication when the reserve price is lowered. Publication is not made of any of the bids that exceeded the current or past published reserve price, therefore proxy bids that exceed the reserve are not published since only those bids that did not exceed the posted reserve price are reconsidered for the reduced reserve price).

Regarding claims 8,26,27,29,34,35,41,59,60 and 66, their limitations are closely parallel to the limitations of claims 1 and 2 and are therefore analyzed and rejected on the basis of same rationale set forth for claims 1 and 2 above.

Response to Arguments

Applicant's arguments filed on 8/24/2009 with respect to currently amended claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **571.272.6755**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeffrey Smith** can be reached on **571.272.6763**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

571-273-8300 [Official communications; including

After Final communications labeled

"Box AF"]

For general questions the receptionist can be reached at

571.272.3600

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/Mark Fadok/
Mark Fadok
Primary Examiner, Art Unit 3625